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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,200	08/22/2001	Roger C. Palmer	077056-0353	8757

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EXAMINER

TRAN, HENRY N

ART UNIT	PAPER NUMBER
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2629

DATE MAILED: 05/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/935,200

Applicant(s)

PALMER ET AL.

Examiner

Henry N. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-15 and 17-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-15 and 17-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Amendment received March 10, 2006 has been entered. Claims 1, 2, 4-15 and 17-28 remain pending in this application. Applicant's Remarks provided in pages 8-9 of the Amendment has been fully considered; and this Office action is in response thereto.

Amendment Practice

2. The Amendments To The Claims section of the Amendment does not comply with the Requirements of 37 CFR 1.121; wherein, the canceled claims must be indicated by only the claim number and status, *without presenting the text of the claims*. For example:

Claim 3 (canceled).

Claim 16 (canceled).

For the purpose of this Office action, the "Claim listing" of claims 3 and 16 that complies with the requirements of 37 CFR 1.121 has been waived. However, an Amendment that does comply with the requirements of 37 CFR 1.121 is required in response to this Office action. See MPEP § 714.03.

Response to Arguments

3. Applicant's arguments filed March 10, 2006 have been fully considered but they are not persuasive.

Applicant argued that applicant's claimed invention as recited in each of the independent claims 1, 8, 18, and 23 requires: dividing and physically applying a decorative element to a window covering; wherein, the selection appears continuous across the first window covering section and the second window covering section when the window covering section is in either

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an open position or a closed position; whereas, the prior art references, the Fenton, Ringland, and Krinsky patents, either alone or in combination, fail to disclose dividing the element across window covering sections so that the element appears continuous whether the covering is open or closed as claimed. Particularly, Krinsky discloses dividing a decorative element across wallpaper panels such that: ...”a coherent visual image ...to provide a complete picture”; also, Krinsky discloses not using individual panels or portions of panels, yet maintaining some combination contiguous panels to produce a coherent image.

The examiner respectfully disagrees because of the following reasons:

Firstly, in response to applicant's argument that the Krinsky patent fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., “using individual panels or portion of panels ... to produce a coherent image”) are not recited in the rejected claims; although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims; See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993);

Secondly, Krinsky patent is relied upon for the teachings of: a decorative element data (“a digital image”) corresponding to a decorative element (“a design”) is selected by a customer; the decorative element data is then divided (“modified”) to produce a customized digital image; the customized design (“subdesign”) is then converted to a visual image that is printed onto suitable substrate for wallpaper; see col. 1, line 50 to col. 2, line 15. Krinsky further teaches that the customer may select a number of panels, and different portions of the design that are corresponding to different sections of each of the panels are selected; and then the selected portions are printed onto a suitable substrate for displaying as a complete decorative element that

appears continuous across sections of the panels arranged side by side in proper sequence for use as a decorative wallpaper (Krinsky teaches that a customer selects a design "A", see Fig. 3A; the customer modifies the selected design "A" by dividing design "A" into 4 equal portions corresponding to 4 equal middle sections (20) of the first 4 panels among a total of 6 panels using a computer as illustrated in Figs. 1 and 3B; wherein, each of the panel comprising an upper section 10, a middle section 20, and a lower section 30, as illustrated in Fig. 1; and then the 4 equal portions of the selected design "A" are printed onto a suitable substrate for displaying as a complete decorative element that appears continuous across sections of the panels arranged side by side in proper sequence for use as a wall coverings; see col. 1, line 45 to col. 2, line 15; and col. 3, line 24 to col. 4, line 4;. The combinations of the prior art references, the Fenton, Ringland, Thomas and Krinsky patents teach all the claimed elements and limitations as claimed invention; see the rejections discussed below; and

Finally, applicant's argument is directed to the newly added claimed elements and limitations, which were not previously cited, as follows: *dividing and physically applying a decorative element to a window covering; wherein, the selection appears continuous across the first window covering section and the second window covering section when the window covering section is in either an open position or a closed position*, which are taught by the Krinsky, Fenton, and Ringland references as discussed hereinafter.

Drawings

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "17" has been used to designate both "Magazine 17" and "Printer 17" (see Fig. 1; the "Printer 17" should be changed to --Printer 15--, see Paragraph [0023], page 7 of the

Specification). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the: "*a first portion*", "*a first window covering section*", "*a second portion*", "*a second window covering section*", "*the selection appears continuous across the first window covering section and the second window covering section when the window covering section is in either an open position or a closed position*", "*the window covering section is in an open position*", and "*the window covering section is in a closed position*" must be shown or the features canceled from the claims. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must

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be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o).

The following claimed terms and/ or phrases do not appear in the specification:

"a first portion", "a first window covering section", "a second portion", "a second window covering section", and "the selection appears continuous across the first window covering section and the second window covering section when the window covering section is in either an open position or a closed position".

Corrections are required in response to this Office action.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 2, 4-11, 15, 17, 18 and 20-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krinsky (U.S. Patent No. 6,354,212) in view of Fenton et al (U.S. Patent No. 6,343,264, hereinafter referred as "Fenton").

Re claim 1, Krinsky teaches a method of applying a decorative element to a window covering, the method comprising the steps of: providing decorative element data corresponding to a decorative element (Krinsky teaches: providing "a digital image", see col. 1, lines 46-48); dividing the selected decorative element data into a first portion corresponding to a first window covering section of the window covering and a second portion corresponding to a second window covering section of the window covering (Krinsky, Figs 1, 3A and 3B, teaches: a customer selects a design "A"; the customer creates a customized digital image or a "subdesign" of the selected design by dividing design "A" into 4 equal portions corresponding to 4 equal middle sections (20) of the first 4 panels selected among a total of 6 panels using a computer as illustrated in Figs. 1 and 3B; wherein, each of the panel comprising an upper section 10, a middle section 20, and a lower section 30, as illustrated in Fig. 1); physically applying the decorative element according to the decorative element data onto a suitable substrate; wherein the decorative element appears continuous across the first panel middle section and the second panel middle section when the window covering is in either an open position or a closed position (Krinsky teaches: the customized design ("subdesign") is then converted to a visual image by printing the customized design onto suitable substrate for displaying as a complete decorative element that appears continuous across middle sections of the selected 4 panels arranged side by side in proper sequence for use as a decoration for wallpaper; see col. 1, line 50 to col. 2, line

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15). However, Krinsky does not teach expressly that the method steps are for applying a decorative element to a window covering in a retail store.

Fenton teaches a system and method for a customer shopping for floor, wallpaper, and window coverings comprising the step of: providing decorative element data (color, col. 2, lines 28-50), and applying the decorative element according to the decorative element data to the window covering in a retail store (customer shopping at the dealer store; col. 1, lines 65-66; col. 6, line 51-54; and col. 7, lines 28-33).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the selection process at the retail store as taught by Fenton in the Krinsky method steps because this would provide an improved and effective selection process to help the dealer and the customer to quickly and easily identify and to select a desired window covering product using the computer visualization program available at a retail dealer; see Fenton, Fig. 2; col. 10, lines 1-8. By this rationale, claim 1 is rejected.

Re claim 2, Krinsky further teaches that the decorative element is an image; see Fig. 3A.

Re Claim 4, Fenton further teaches that the step of providing decorative element data includes scanning a sample provided by a customer; see col. 8, lines 51-54.

Re claim 5, Fenton further teaches that the step of providing decorative element data includes reading an electronic file provided by the user; see col. 6, lines 30-42.

Re claim 6, Fenton further teaches that the step of displaying the decorative element applied to the window covering on a monitor; see col. 7, line 60 to col. 8, line 21.

Re claim 7, Krinsky teaches the step of physically applying the decorative element includes printing the decorative element onto a suitable substrate; see col. 1, lines 58-60.

Re claim 18, Krinsky teaches a system for applying a decorative element to a wall covering comprising the use of: a printer coupled to the computer and configured to print a selected decorative element onto a suitable substrate for use as a decorative wall covering; see Fig. 3B, col. 1, line 45 to col. 2, line 15; and col. 4, lines 46-50; and a computer program for distributing the selected decorative element across a surface of the wall covering (present the design on a display screen, step 50), dividing the selected decorative element between a first panel covering section and a second panel covering section, and rendering the selected decorative element onto an image of the wall covering to provide a visual image of the selected decorative element on the selected wall covering sample to the user; wherein the selection appears continuous across the first panel covering section and the second panel covering section when the panel covering is in either an open position or a closed position (customer selection and customization, steps 60 and 80; and the customized design is printed, step 90).

Fenton teaches a system (30) for applying a decorative element to a window covering in a retail location, the system comprising: a computer device (32) configured to store and recall a decorative element data; see col. 7, lines 60-66); window covering data to display images of the selected decorative element applied to the window covering; means for user selection of a window covering sample (Fenton teaches that the computer program such as PhotoShop, ColorShop, display monitor (16), a digital camera, a color-analyzer (12), and a scanner (14) are used as a means for a customer to select a color, and then superimpose on a window covering sample presented on the computer screen for the customer to see; see col. 4, lines 13-18; col. 5, lines 47-55; col. 6, lines 6-17, lines 49-50, and lines 66-67); and a computer program for a customer to perform a selection process when shopping for window coverings at retail store

(Fenton teaches the use of a computer program, such as PhotoShop program, see col. 1, line 63 to col. 2, line 10; and col. 7, line 60 to col. 8, line 5).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the computer program for performing a selection process at the retail store as taught by Fenton with the Krinsky computer system because this would provide an improved and effective selection process to help the dealer and the customer to quickly and easily identify and select a desired window covering product using the computer visualization program available at a retail dealer; see Fenton, Fig. 2; col. 10, lines 1-8. By this rationale, claim 18 is rejected.

Re claim 17, Fenton further teaches that the system further comprising a scanner configured to spectrophotometrically measure a color sample; see col. 4, lines 35-52.

Re claims 20-22, Krinsky further teaches the use of a printer, such as the ink-jet printer, which includes a magazine, which is an inherent element: “paper feeder trays”, for feeding a paper substrate; and a curing apparatus, which is another inherent element: “air blower”, for curing the selected decorative element printed on a suitable substrate, e.g., a paper; see col. 4, lines 46-50); and the decorative element is an image; see Fig. 3A.

Re claims 23-27, which comprise similar claimed elements and limitations of claims 17, 18 and 20-22, rephrased to recite: a memory, a display, and an input device for accepting choices from the user. As discussed in claim 18 above, Fenton teaches a system (30) for applying a decorative element to a window covering in a retail location, the system comprising: a computer system including: a processor (32), a display (16), a memory (e.g. RAM), and computer graphics program, such as PhotoShop, ColorShop, etc., configured for a customer to customize a window covering data to display images of the selected decorative element applied to the window

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covering; see col. 4, lines 13-18; col. 5, lines 47-55; col. 6, lines 6-17, lines 49-50, and lines 66-67). Krinsky teaches that the decorative element is printed onto a suitable substrate; see col. 1, lines 58-60; wherein, the decorative element appears continuous across the first panel middle section and the second panel middle section when the window covering is in either an open position or a closed position; see the rejection of claim 1 discussed above. By this rationale, claims 23-27 are rejected on the same reasons set forth in claims 1, 17, 18 and 20-22 discussed above.

Re claims 8-10, which are method claims corresponding to the apparatus claims 17, 18, 22, and are therefore rejected on the same basis set forth in claims 17, 18 and 22 discussed above.

Re claim 11, Fenton further teaches the step of scanning a sample; see col. 8, lines 51-54.

Re claim 15, Fenton further teaches the step of displaying images includes rendering at least one decorative element onto a computer model of the window covering; see col. 9, lines 4-11.

9. Claims 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krinsky (U.S. Patent No. 6,354,212) in view of Fenton (U.S. Patent No. 6,343,264), hereinafter referred to as “Krinsky-Fenton”, as applied to claims 1, 2, 4-11, 17, 18 and 20-27 above, and further in view of Ringland et al (U.S. Patent No. 6,122,391, hereinafter referred to as “Ringland”).

Krinsky-Fenton teaches generally all except for the steps of: storing the searchable data compilation on a removable storage medium, which is a CD-ROM; and accessing a file containing the searchable data compilation.

Ringland teaches a method for applying a decorative element to a window covering, the method comprising the steps of: storing the searchable data compilation of decorative elements on a storage device, which is a removable CD-ROM (database on CD-ROM; see col. 12, lines 55-56); and accessing a file containing the searchable data compilation for selection a decorative element for viewing by a customer (GUI module, column 15, lines 45-46; and steps 408, 410, and 412; see Fig. 4).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the removable CD-ROM as taught by Ringland for storing searchable product database and files used in the Krinsky-Fenton system because this would provide a convenient and inexpensive way to hold a large number of color images, samples, and program files for enhancing the functionality and reliability of the selection process; see Ringland, col. 7, lines 45-60. Claims 12-14 are dependent upon the base claim 8, and are therefore rejected on the same reasons set forth in claim 8, and by the reasons discussed above.

10. Claims 19 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over “Krinsky-Fenton”, as applied to claim 18 above, and further in view of Thomas et al (U.S. Patent No. 6,005,969, hereinafter referred to as “Thomas”).

Krinsky-Fenton teaches generally all except for the: the computer is coupled to a network or an Internet server so that the decorative element data from a remote location is searchable or recallable, or the decorative element data is stored on a remote computer.

Thomas teaches a system for manipulation in the design and selection of decorative window coverings; wherein, the decorative samples or designs can be stored on a remote computer connected to a network or an internet server so that the decorative element data from a

remote location is searchable or recallable, or the decorative element data is stored on a remote computer, see abstract.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the remote computer or an internet server as taught by Thomas in the Krinsky-Fenton system because this would provide an enhanced selection program process which would conveniently and effectively assist vendors as well as customer to be able to perform selective shopping for decoration designs.

Claims 19 and 28 are dependent upon the base claim 18, and are therefore rejected on the same reasons set forth in claim 18, and by the reasons discussed above.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. They are U.S. Patents Nos.: 6,664,972 issued to Eichel et al, and 6,920,606 issued to Jablonski et al., which teach systems and methods for designing treatments for interior spaces.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

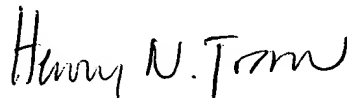
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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Henry N. Tran whose telephone number is 571-272-7760. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, RICHARD A. HJERPE can be reached on 571-272-7691. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Henry N Tran
Primary Examiner
Art Unit 2629

HT
5/19/06